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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Harmon et al.	
Application No.:	10/729,046	Group Art Unit: 3738
Filed:	December 5, 2003	Examiner: Alvin J. Stewart
Entitled:	VIABLE TISSUE REPAIR IMPLANTS AND METHODS OF USE	
Docket No.:	22956-235 (MIT-5023)	

Certificate of Mailing (37 C.F.R. 1.8(a))

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March 7, 2005 — Date of Signature and Mail Deposit

By: — William C. Geary III, Reg. No: 31,359, Attorney for Applicant(s)

Commissioner for Patents
MS Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Dear Sir:

This is in response to the Office Action mailed February 8, 2005.

The Examiner requires an election of the above-referenced application to one of the following species:

Species I: Figures 1A-1C;
Species II: Figures 2A-2C; and
Species III: Figures 3A-3C.

Applicants elect Species I, with traverse.

Applicants submit that claims 1-6, 8-13, 20, and 23-27 are drawn to Species I, the elected species. Further, claims 1-6, 8-13, 20, and 23-27 are generic to all species because they do not include any material element additional to those recited in the species claims, and comprehend the organization covered in each species. MPEP § 806.04(d).

Although the Examiner has requested a further election of a sub-species, Applicants believe such a further election to be improper. Nevertheless an election of sub-species is provisionally made below following the arguments that traverse the election requirement.

Applicants believe that the election requirement is improper because Applicants present an allowable claim generic to all species.

37 C.F.R. § 1.141 states:

> [M]ore than one species of an invention….may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all claims to species in excess of one are written in dependent form or otherwise includes all the limitations of the generic claim.

As noted above, claims 1-6, 8-13, 20, and 23-27 are generic, with claims 1 and 20 being independent claims. All of the other pending claims, whether generic or not, are dependent from claims 1 and 20. Thus, because all of the other pending claims are dependent from an allowable

generic claim (either claim 1 or claim 20), Applicants may claim more than one species in the present application. As such, restriction is improper.

The Examiner further requires election of one of the following "sub-species:"

For Species I:
Sub-Species A: Figure 1A;
Sub-Species B: Figure 1B; and
Sub-Species C: Figure 1C.

For Species II:
Sub-Species A: Figure 2A;
Sub-Species B: Figure 2B; and
Sub-Species C: Figure 2C.

For Species III:
Sub-Species A: Figure 3A;
Sub-Species B: Figure 3B; and
Sub-Species C: Figure 3C.

As noted above, Applicants' elected Species I with traverse. Accordingly, Applicants' further elect Sub-species A (Figure 1A), also with traverse.

As noted above, Applicants submit that claims 1-6, 8-13, 20, and 23-27 are drawn to Species I, the elected species. Applicants submit that the same are drawn to Sub-species A, the elected sub-species.

The requirement of the election of a sub-species is improper due to ambiguity in the Office Action, and because the language of 35 U.S.C. § 121 permits the prosecution of all "sub-species" in this application.

In the Office Action, the Examiner states:

> This application contains claims directed to the following patentably distinct species of the claimed invention: Species I, referring to Figs. 1A-1C; Species II, referring to Figs. 2A-2C; Species III, referring to Figs. 3A-3C.

> **Upon election of Species I a further election of sub-species is required.**
> Sub-species A, referring to Fig. 1A; Sub-species B, referring to Fig. 1B; and Species C, referring to Fig. 1C.
> Upon election of Species II a further election of sub-species is required.
> Sub-species A, referring to Fig. 2A; Sub-species B, referring to Fig. 2B; and Species C, referring to Fig. 2C.
> Upon election of Species III a further election of sub-species is required.
> Sub-species A, referring to Fig. 3A; Sub-species B, referring to Fig. 3B; and Species C, referring to Fig. 3C.
> **Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits** to which the claims shall be restricted if no generic claim is finally held to be allowable.

(Emphasis added.) As can be seen from the above, the Examiner first requests the election of a sub-species, and then subsequently requests the election of a species alone. Thus, because of the ambiguity in his instructions to Applicants, the requirement that Applicants elect a sub-species is improper.

Further, because 35 U.S.C. § 121 (which is quoted by the Examiner in the Office Action above) does not require the election of a sub-species, the requirement that Applicants elect a sub-species is improper.

In sum, claims 1-6, 8-13, 20, and 23-27 are generic, and claims 1-6, 8-13, 20, and 23-27 are directed to the elected Species I, as well as elected Sub-Species A. Accordingly, should restriction be required, claims 7, 14-19, and 21-22 are withdrawn from consideration.

The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

Date: March 7, 2005

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